

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SHRIKANT N. PARIKH,  
GEORGE C. MANTHURUTHIL,  
and HARI N. REDDY

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Appeal No. 1997-2988  
Application No. 08/045,499

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ON BRIEF

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Before THOMAS, HAIRSTON, and KRASS, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims  
1 through 3 and 5 through 12. In an Amendment After Final<sup>1</sup>

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<sup>1</sup>The amendment was submitted in response to the new ground of rejection in the Answer.

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(paper number 9), claims 1 and 5 through 7 were amended.

The disclosed invention relates to a method and apparatus for filling in a form with a data processing system.

Claims 1 and 11 are illustrative of the claimed invention, and they read as follows:

1. A method of filling in a form with a data processing system, comprising the steps of:
  - a) providing a paper path with a scanner located upstream from a means for printing on paper;
  - b) locating said form on said paper path;
  - c) locating a segment of said form adjacent to said scanner;
  - d) scanning said segment of said form with said scanner and displaying said scanned segment on said data processing system;
  - e) accepting information in selected locations on said scanned segment;
  - f) maintaining said form on said paper path and advancing said form along said paper path so as to move said scanned segment from said scanner to said means for printing on paper;
  - g) printing said information in said selected locations on said scanned segment with said means for printing on paper and repeating steps c)-g) with a next segment until said form has been completed.

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11. An apparatus for filling in a form, comprising:

- a) a user interface;
- b) a data processing system connected to said user interface;
- c) a printer connected to said data processing system, said printer further comprising means for printing on paper, a paper path located adjacent to said means for printing and a scanner located adjacent to said paper path and upstream along said paper path from said means for printing, said scanner being located a distance along said paper path from said means for printing, said distance being less than a length of said form.

The references relied on by the examiner are:

Vollert 1988	4,755,877	Jul. 5,
Makihara 1992	5,129,053	Jul. 7,
Hirose et al. (Hirose) 1987	0 232 905	Aug. 19,

(published European Patent Application)

Claims 1 through 3 and 5 through 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Makihara in view of Hirose.

Claims 1 through 3 and 5 through 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Makihara in view of Vollert.

Reference is made to the briefs and the answers for the respective positions of the appellants and the examiner.

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OPINION

At a minimum, apparatus claims 11 and 12 on appeal require a scanner and a printer located adjacent a paper path with the scanner positioned upstream along the paper path from the printer. The Figure 11 and the Figure 18 embodiments of Hirose disclose such structure in a word processing/data processing system. In both embodiments, the user interface to the word processor is a keyboard. The Figure 11 embodiment discloses "a printer [109] connected to said data processing system, said printer [109] further comprising means for printing on paper [135], a paper path [P<sub>6</sub>-P<sub>7</sub>] located adjacent to said means for printing [109] and a scanner [108] located adjacent to said paper path and upstream along said paper path from said means for printing, said scanner being located a distance along said paper path from said means for printing, said distance being less than a length of said form." In Figure 11, the rollers 129, 130, and 138 are "means for moving said form by said means for printing and said scanner." The Figure 18 embodiment of Hirose has a scanner 208 and a printer 209 located adjacent to a paper path P<sub>9</sub>-P<sub>10</sub>. The scanner is located upstream from the printer along the paper path, and

the distance between the scanner and the printer is less than the length of the paper. The Figure 18 embodiment also uses rollers to move the paper by the printer and the scanner. Nothing in claims 11 and 12 requires the scanner to interact with the paper in the paper path.

In view of the foregoing, we find that all of the limitations of apparatus claims 11 and 12 read directly on the Figure 11 and Figure 18 embodiments of Hirose. In affirming a multiple reference rejection under 35 U.S.C. § 103, the Board may rely on one reference alone without designating it as a new ground of rejection. In re Boyer, 363 F.2d 455, 458, n.2, 150 USPQ 441, 444, n.2 (CCPA 1966); In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961). Thus, the obviousness rejection of claims 11 and 12 is sustained based upon the teachings of Hirose considered alone.

The remainder of the claims on appeal require interaction between the scanner and the paper in the paper path. As indicated supra, the scanners in the two noted embodiments of Hirose do not interact with the paper in the paper path. In the Figure 4 embodiment of Hirose, there exists a first paper path  $P_3$ - $P_4$  for the scanner 8, and a second paper path  $P_1$ - $P_2$  for

the printer 9. Accordingly, the Figure 4 embodiment of Hirose lacks a paper path with both a scanner and a printer adjacent to it or on it. The reference to Makihara does not provide any discussion concerning the relative locations of the scanner 3 and the printer 4 with respect to any paper path. Even if such information were provided in Makihara, the relevance of this reference eludes us in that we agree with the appellants (Brief, page 7) that "Makihara utilizes full size scanners, wherein the entire document is scanned at one time." In summary, the differences between claims 1 through 3 and 5 through 10 and the teachings and suggestions of Makihara and Hirose are too numerous for the examiner to fashion a plausible combination of their teachings. In any event, nothing is found in the answers that convinces us that the examiner has presented a prima facie case of obviousness based upon the combined teachings of Makihara and Hirose. As a result thereof, the obviousness rejection of claims 1 through 3 and 5 through 10 based upon the teachings of Makihara and Hirose is reversed.

Turning next to the obviousness rejection of claims 1 through 3 and 5 through 12 based upon the teachings of



Makihara and Vollert, we find that the teachings of Vollert add very little to the irrelevant teachings of Makihara. When the scanner 6 is used in a facsimile mode, all of the sheet 11 is scanned (column 5, line 67 through column 6, line 3), and when the scanner 6 is used in a copier mode, the entire sheet is scanned (column 6, lines 12 through 29). The claimed requirement that the scanner be upstream along the paper path from the printer can never be met by Vollert because the scanner 6 and the printer 4 are mounted in a side-by-side arrangement (column 6, lines 29 through 36; Figure 2) (Reply Brief, pages 5 and 6). In summary, the obviousness rejection of claims 1 through 3 and 5 through 12 based upon the teachings of Makihara and Vollert is reversed because we agree with appellants' argument (Reply Brief, page 6) that "[c]ombining Makihara with Vollert to achieve Applicants' invention will not work."

#### DECISION

The decision of the examiner rejecting claims 1 through 3 and 5 through 12 under 35 U.S.C. § 103 is affirmed as to claims 11 and 12, and is reversed as to claims 1 through 3 and 5 through 10. Accordingly, the decision of the examiner is

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affirmed-in-part.

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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 C.F.R.  
§ 1.136(a).

AFFIRMED-IN-PART

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JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
KENNETH W. HAIRSTON	)	)
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
ERROL A. KRASS	)	)
Administrative Patent Judge	)	

KWH:hh

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